THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN M. KNIFFIN, RON McCAULEY, RALPH H. WELLS, III, JOHN W. SHERMAN and WAYNE F. LARSON

Appeal No. 96-1657
Application 07/819,345[1]

ON BRIEF

Before KRASS, JERRY SMITH and LALL, Administrative Patent Judges.

LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 47.

The invention relates to secure entry systems and

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[1] Application for patent filed January 9, 1992.

methods, particularly electronic real estate lockboxes. Lockboxes are provided with electronic lockout list memories identifying keyholders that are to be denied entry to the lockbox. Whenever a keyholder tries to access the lockbox using his electronic key, the key ID is compared with the key IDs stored in the lockout list. In one aspect of the invention, the lockout list is continuously updated to avoid access by a stolen key. A real estate agent contacts the central station using a remote means and requests advance permission to show a house. The central station then checks a master database of user qualifications to determine whether that particular agent should be granted permission to access that particular house, i.e., lockbox and responds accordingly. In another aspect of the invention, a pocket pager is adapted to also serve as an electronic key for a secure access system. A conventional pager additionally includes a communication interface for interfacing with a secure entry system. In another embodiment, a cellular telephone is used in lieu of an electronic key. In such systems, the lock is provided with a radio receiver through which it receives unlocking instructions. A real estate agent uses a cellular telephone

to transmit a tone-modulated signal. The tones issued by the cellular telephone are received and serve to unlock the lockbox.

Claims 1, 16 and 17 are selected as representative of the invention and are reproduced below:

1. A method of operating a secure entry system, the system including a lock that controls access to a secure area, the system further including a central station, the method comprising the steps:

establishing communication between the central station and a user remote from the central station;

identifying to the central station the lock to which the user seeks access, said identifying not requiring the user be in proximity with the lock;

verifying access qualification of the user to the central work station;

transmitting to the lock a radio authorizing signal to authorize the user to access the area secured by the lock;

identifying the presence of the user at the lock; and

operating a mechanism associated with the lock to aid in entry to the area secured by the lock.

16. An apparatus useful with a paging system and with a secure entry system, the secure entry system including a lock mechanism, the apparatus comprising a housing that includes therein:

a battery;

data processing circuitry coupled to the battery;

a receiver adapted to receive messages, including radio frequency paging messages, targeted to the apparatus, the receiver having a power input coupled to the battery and a data output coupled to the data processing circuitry;

a signaling device to alert a user of a received message, the signaling device being coupled to the data processing circuitry;

memory circuitry having stored therein authorization data that is useful in operating the secure entry system, said memory circuitry being coupled to the data processing circuitry;

a communications interface adapted to transfer data between the apparatus and the secure entry system so that the lock mechanism may be activated, the communications interface being coupled to the data processing circuitry; and

means for rendering the apparatus unable to activate the lock mechanism unless the apparatus is provided, from time to time, with new authorization data;

wherein the apparatus can serve both as a paging message receiver and as an access device for a secure entry system.

17. A method of operating a secure entry system, the secure entry system including an access control device that has a radio receiver, processing circuitry, and a lock mechanism associated therewith, the method comprising the steps:

operating a cellular telephone to make a radio broadcast, the radio broadcast including signal tones modulated thereon;

receiving said broadcast including signal tones;

providing data signals corresponding to the received

signal tones to the processing circuitry associated with the access control device;

operating the lock mechanism in response to said provided data signals; and

storing data relating to the lock operation in a memory, the data indicating at least the date the lock was operated.

The Examiner relies on the following reference:

White	4,275,385	Jun. 23, 1981
Henderson et al.(Henderson)	4,766,746	Aug. 30, 1988
Marian	4,962,522	Oct. 9, 1990
Ryoichi et al.(Ryoichi)	5,113,427 (filed Aug. 24, 1990)	May 12, 1992

Marino, “Pager and Garage Door Opener Combination”, MOTOROLA, Technical Developments, vol. 10, p. 36 (March 1990). (Hereafter, referred to as "Motorola" for consistency).

Claims 16 and 22 through 27 stand rejected under 35 U.S.C. § 103 over Motorola and Henderson.

Claims 1 through 8 and claims 28 through 33 stand rejected 35 U.S.C. § 103 over White.

Claims 17 through 21, claims 1 through 15 and claims 28 through 47 stand rejected under 35 U.S.C. § 103 over Ryoichi, Marian and Henderson.

Rather than repeat the arguments of Appellants or the

Examiner, we make reference to the briefs[2] and the answer for the respective details thereof.

OPINION

We have considered the rejections advanced by the Examiner and the supporting arguments. We have, likewise, reviewed the Appellants' arguments set forth in the brief and the reply brief.

It is our view that the rejection under 35 U.S.C. § 103 over White is affirmed with respect to claims 1 through 5 and 28 through 31, but reversed with respect to claims 6 through 8, 32 and 33; the rejection under 35 U.S.C. § 103 over Motorola and Henderson is affirmed with respect to claims 16 and 22 through 27; and the rejection under 35 U.S.C. § 103 over Ryoichi, Marian and Henderson is reversed with respect to claims 1 through 15, 17 through 21 and 28 through 47. Accordingly, we affirm in part.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28

[2] A reply brief was filed on Jan. 22, 1996 [paper no. 21] and was entered in the record [paper no. 26].

USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being

interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply

deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the Appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we analyze the prior art applied by the Examiner in the rejection of the claims on appeal.

The Examiner has rejected all the claims under 35 U.S.C. § 103 over various combinations of Motorola, Henderson, White, Ryoichi and Marian. Appellants have elected that claim 4 stands or falls with claim 2, claims 18 to 20 with 17, and claims 28, 29 and 31 with claim 1. According to Appellants, all the other claims are patentably distinct from each other [brief, page 6].

We consider the various rejections in the same order as

they appear in the brief.

A. Rejection of claims 16 and 22 through 27 over Motorola and Henderson

We treat the independent claim 16 first. With respect to this claim, we have reviewed the Examiner's position [answer, pages 4 to 5] and Appellants' corresponding arguments [brief, pages 9 to 10, and reply brief, pages 3 to 5 and 8 to 10]. Appellants argue that Motorola teaches away from the proposed combination because it would be a hardship on a homeowner to have to update the data in a pager/garage door opener periodically in order to maintain the ability to open the garage door. We do not agree.

Initially, we note that while there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as the appellants would apparently have us believe. Rather, the test for

obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Motorola contemplates the use of the disclosed garage door opener in business, or even an opener for a door on vehicles such as delivery trucks. Certainly, it would have been desirable to permit only the authorized person to access such a door, and, in a business setting, the list of authorized persons to access the door would, of necessity, change continuously. We, therefore, find that the combination of Motorola and Henderson is justified and the obviousness rejection of claim 16 over Motorola and Henderson is proper.

With respect to the dependent claims 22 to 27, the Examiner has stated that they contain features which are well known and conventional in the art of access control, and

moreover are shown by Henderson [answer, page 5]. Appellants have not presented any specifics as to why these features are not well known and conventional. In fact, Appellants only contend that "the mere existence of a feature in the prior art does not render obvious all combinations including that feature." [brief, page 11]. Regarding claim 22, the only claim in this group addressed individually by Appellants, Appellants state that Henderson does not show the feature added by this claim. We disagree. Henderson shows key 14 to update the lockout list [column 20, line 54 to column 21, line 7], and the keys on the key pad 14 can serve as the contacts through which new authorization data can be provided. We find claims 23 and 24 are met by the same cite of Henderson. The feature claimed in claim 25 is shown by figure 13 of Henderson. The battery in Motorola can be considered to power the lock mechanism, claim 26. With respect to claim 27, Henderson shows such access system for a real estate lockbox. In the absence of any specific rebuttal to the Examiner's position on these claims, the obviousness rejection of claims 22 through 27 over Motorola and Henderson is justified.

B. Rejection of claims 1 through 8 and claims 28 through 33 over White

We consider the rejection of the independent claim 1. We have considered the Examiner's position [answer, pages 5, 6 and 14] and Appellants' corresponding arguments [brief, pages 12 to 15 and reply brief, pages 3 to 5 and 8 to 10]. Appellants argue that White's personnel locator system is completely different and fails to suggest many of the claimed combinations. As an example, Appellants contend that White fails to show: "identifying to the central station the lock to which the user seeks access" [claim 1, line 6], and "said identifying not requiring the user be in proximity with the lock;" [claim 1, line 6 to 7]. However, we agree with the Examiner. Claim 1 calls for a method of operating a secure system including a lock that controls access to a secure area, the system further including a central station. The method comprises a number of steps including the two substeps argued by Appellants above. White does control the access to a secure area. Locks CL1 ... CL256 [figure 1] are employed for that purpose. As for the first substep, we note that a transmitter [the user] transmits an identifying signal. This

signal and another signal regarding the information about the receiving station [the lock] are sent to the central station, which verifies if that user has an authorized access to the lock. [White, column 2, lines 2 to 66]. If that validation fails, the user experiences a lockout, otherwise the user is allowed access. As for the second substep, i.e., said identifying not requiring the user be in "proximity with the lock", the clause "proximity with the lock" is a relative term and White contemplates that transmitter units T1 through T256 [figure 1] periodically communicate ... to remote [not proximate] receiver stations R1 through R2564. [Column 5, lines 20 to 23].

Appellants further argue that failure of White to use radio signals to communicate between the transmitters and the receiving stations is an indication that White teaches away from the invention of claim 1. [Brief, page 14]. We agree with the Examiner in that even though White does not use radio communication between the transmitters and the receiving stations, it does clearly teach that remote receiver stations can communicate with control unit C1 over wire, cable or by radio transmission. [Column 5, lines 38 to 40]. We find that

this suggestion justifies that it would have been obvious, to one of ordinary skill in the art at the time of the invention, to use radio transmission between the transmitters and the receiver stations in place of the infrared signals. This is so because the prior art need not show each and every element of the invention. Additionally, we observe that an artisan must be presumed to know something about the art apart from what the

references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Thus, we conclude that the obviousness rejection of claim 1 over White is proper.

With respect to claim 2, White shows the receiver station

being authorized by the central processor to grant access for a time window [column 12, lines 2 to 9]. Claim 3 calls for a timer being programmed by a radio signal to the lock for a time window [of access]. We find that White, at column 11, line 66 to column 12, line 9, sets up a time window for access to the secure area, a timer being inherent to accomplish the operation of such a time window. Claim 4 falls with claim 2 above. For claim 5, White does show the logging access data to the operation of the lock mechanism [column 2, line 66 to column 3, line 6]. Thus, we conclude that the obviousness rejection of claims 2 through 5 over White is also sustainable.

Regarding claims 6 to 8, we agree with Appellants [brief, pages 19 to 21] that White does not show or suggest these features. The Examiner has not pointed to any specific place in White for these features and we have not found them in White. Therefore, the obviousness rejection of claims 6 through 8 is not sustainable.

With respect to claims 28, 29 and 31, they fall with claim 1. Regarding claim 30, White, at column 11, line 67 to

column 12, line 9, teaches that a signal is sent to the lock [receiving station] to program a specific time window for access to the secure area. Therefore, the obviousness rejection of claims 28 through 31 over White is sustained.

Regarding claims 32 and 33, we have reviewed the Examiner's position [answer, pages 6 and 11 to 14] and the Appellants' corresponding arguments [brief, pages 22 and 23]. The Examiner has not identified any portions of White, or given any specific arguments, for his position and consequently Appellants have not made any factual arguments. We also do not find any support in White for the Examiner's position. Consequently, we do not sustain the obviousness rejection of claims 32 and 33 over White.

C. Rejection of claims 1 through 15, claims 17 through 21 and claims 28 through 47 over Ryoichi, Marian and Henderson

At the outset, we agree with Appellants that these three references are not properly combinable [brief, page 8 and reply brief, pages 4, 5, 8 to 10]. The Examiner's contention to the contrary is not convincing [answer, page 14]. Ryoichi relates to an automatic locking system for an automobile, only

limited authorization is required and nothing is contemplated about multiple authorization for multiple users as required in accessing a real estate lockbox. The second reference, Marian, has nothing to do with any kind of secure access system, but rather, deals with an electronic controller for sprinkler systems. There may be numerous applications where Marian's device, having the capability of generating a single paging signal containing plural control signals to control plural systems, can be used, however, there is no suggestion, explicit or otherwise, that it can be combined with a single lock system disclosed by Ryoichi. The third reference, Henderson concerns the electronic real estate lockbox system. The purpose of Henderson's system is so different and diverse from that of Ryoichi's system that we find no reason to justifiably combine Henderson with Ryoichi.

The Federal Circuit has stated that "[the] mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the

prior art suggested the desirability of the modification." In re Fitch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). "Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor." Para-Ordnance Mfg. V. SGS Importers Int'l, 73 F.3d 1087, 37 USPQ 2d at 1239 (Fed. Cir. 1995), citing W. L. Gore & Assocs., v. Garlock, Inc., 721 F.2d at 1551, 1553, 220 USPQ at 311, 312-13 (Fed. Cir. 1983).

Thus, we find that the Examiner has not established a case for combinability of these references. Nevertheless, we review the arguments of the Examiner and Appellants in regard to the rejection based on the combination of Ryoichi, Marian and Henderson.

We start with the rejection of the independent claim 1. We have reviewed the Examiner's position [answer, pages 7 to 11] and Appellants' corresponding arguments [brief, pages 23 to 27]. Ryoichi does not teach the limitations: "verifying access qualifications of the user to the central station" [claim 1, line 8]; and "identifying the presence of the user at the lock" [claim 1, line 11]. The Examiner has not

explained how the addition of Henderson and Marian meets these limitations. Therefore, we conclude that the rejection of claim 1 under 35 U.S.C. § 103 over Ryoichi, Marian and Henderson is reversed. Since claims 2 through 8 and claims 28 through 33 contain at least the same limitations, being dependent on claim 1, their rejection under 35 U.S.C. § 103 over Ryoichi, Marian and Henderson is also reversed.

With respect to the independent claim 9, we have considered the Examiner's position [answer, pages 8 to 9] and Appellants' corresponding arguments [brief, pages 25 to 27]. We conclude that the combination of Ryoichi, Marian and Henderson does not meet the limitations: "verifying access qualifications of the user to the central station" [claim 9, line 7]; and "transmitting to the key a radio enabling signal so as to enable the key to access the lock" [claim 9, lines 8 to 9]. Therefore, the obviousness rejection of claim 9 and its dependent claims, 10 to 15 and 41 to 47, over Ryoichi, Marian and Henderson is reversed.

Regarding the independent claim 17, we have studied Examiner's rejection and arguments [answer, pages 7 to 8] and Appellants' corresponding rebuttal [brief, pages 30 to 31].

One of the limitations of claim 17 is: “storing data relating to the lock operation in a memory, the data indicating at least the date the lock was operated.” [Claim 17, lines 10 to 11]. Even though Henderson individually shows the storing of a log of data relating the use of the lock to access the secure area [figure 13], the Examiner has not shown how this feature of Henderson can be combined with Ryoichi. Similarly, the Examiner does not explain how Marian’s system with the capability of generating a single paging signal carrying plural control signals can be combined with Ryoichi to meet the limitation: “providing data signals corresponding to the received signal tones to the processing circuitry associated with the access control device;” [claim 17, lines 7 to 8]. Therefore, we reverse the obviousness rejection of claim 17 and its dependent claims, 18 to 21 and 34 to 40, over Ryoichi, Marian and Henderson.

In summary, we have affirmed the Examiner regarding the rejection of claims 1 through 5, and 28 through 31 under 35 U.S.C. § 103 over White, and reversed with respect to claims 6 through 8, 32 and 33 under 35 U.S.C. § 103 over White. We have also affirmed the Examiner with respect to claims 16 and

22 through 27 under 35 U.S.C. § 103 over Motorola and Henderson. However, we have reversed the Examiner with respect to the rejection of claims 1 through 15, 17 through 21 and 28 through 47 under 35 U.S.C. § 103 over Ryoichi, Marian and Henderson. Accordingly, the decision of the Examiner rejecting claims 1 through 47 under 35 U.S.C. § 103 is affirmed in part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
PARSHOTAM S. LALL Administrative Patent Judge	)	

Appeal No. 96-1657
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